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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/935,395

Applicant(s)

BATRA ET AL.

Examiner

Kevin Schubert

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11172005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-39 have been considered.

Continued Examination Under 37 CFR 1.114

5 A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/17/05 has been entered.

10

Specification

The Specification is objected to in accordance with the 112, first paragraph, written description requirement below.

15

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

20

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

25

Claims 1-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

30

Examiner finds no disclosure of "exchanging identification data with a remote computer system" and "determining, based on the identification data, whether a predefined security policy exists corresponding to the remote computer system" (see claims 1, 14, and 27). Specifically, Examiner finds no mention of determining whether a predefined security policy exists corresponding to the remote computer

Art Unit: 2137

system based on identification data exchanged with a remote computer system. Appropriate correction or a specific reference as to where the above limitations are disclosed in the Specification is required.

Further, Examiner finds no disclosure of **"selecting** a security policy specification format capable of being utilized by a plurality of different operating systems and a plurality of different machine types **if a**
5 **predefined security policy is absent"** (see claims 1, 14, and 27) or "automatically configuring an IP security tunnel between the data processing system and the remote computer system utilizing said security policy specification format" (claims 14 and 27).

As best understood by Examiner, applicant teaches the creation of a tunnel using VPN configuration data. A local-remote pair is selected from an endpoints table (410 of Fig 4). If the pair is
10 found, a policy is selected from a policy table if found (460 of Fig 4) or a default policy is used (455 of Fig 4). If the pair is not found, an error is returned declaring that a user needs to configure a tunnel (425 of Fig 4). Nowhere in the above description or the Specification as a whole does the Examiner find support for the newly added claim limitations. Appropriate correction or a specific reference to where the instant claimed invention is disclosed in the Specification is required.

15

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20

Claims 2-4, 15, and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2, Applicant has referred to "said security policy specification format" in part b. It is unclear whether this reference is to the "security policy specification format" mentioned in part a of
25 claim 2 or the "security policy specification format" mentioned in claim 1. Appropriate correction is required.

Art Unit: 2137

Claims 16-17 recite the limitation "said DTD file". There is insufficient antecedent basis for this limitation in the claim.

Claims 14-39 recites the limitation "said data processing system" in claims 14 and 27. There is
5 insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

10 A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the
15 invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20 Claims 1,5-14,18-27, and 31-39 are rejected under 35 U.S.C. 102(e) as being anticipated by D'Sa, U.S. Patent Application Publication No. 2002/0178355.

As per claims 1,14, and 27, the applicant describes a data processing system for defining a configuration of IP security tunnels comprising the following limitations which are met by D'Sa:

25 a) exchanging identification data with a remote computer system ([0041],[0047]-[0048],Fig2);

b) determining, based on the identification data, whether a predefined security policy exists corresponding to the remote computer system ([0041],[0047]-[0048],Fig2);

c) selecting a security policy specification format capable of being utilized by a plurality of different operating systems and a plurality of different machine types if a predefined security policy is
30 absent ([0041],[0047]-[0048],Fig 2);

Art Unit: 2137

d) said system for automatically configuring an IP security tunnel between the data processing system and the remote computer system utilizing said security policy specification format ([0042],[0047]-[0048],Fig 2).

5 As per claims 5-11,18-24, and 31-37, the applicant describes the system of claims 1,14, and 27, which are met by D'Sa (see above), with the following limitations which are met by D'Sa:

- a) a root element ([0070]);
- b) a protection element ([0099]);
- c) a transform element ([0090], [0153]);
- 10 d) a group element ([0065]);
- e) an identification element ([0066]);
- f) a tunnel element ([0138], [0139], [0177]);
- g) a local/remote identify element ([0058], [0061]);
- h) an ID type element ([0066]);
- 15 i) an ID definition element ([0067]);
- j) a pre-shared key element ([0099]);
- k) an IPsec proposal element ([0071], [0072]);
- l) an IPsec authentication header element ([0146]);
- m) an IPsec protection element ([0146]);

20

As per claims 12-13,25-26, and 38-39, the applicant describes the system of claims 1,14, and 27, which are met by D'Sa (see above), with the following limitation which is met by D'Sa:

Further comprising the step of automatically configuring an IP security tunnel utilizing said security policy specification format ([0040] and [0041]);

25

Claims 1,14, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Bendinelli, U.S. Patent No. 6,631,416.

Art Unit: 2137

As per claims 1, 14, and 27, the applicant describes a data processing system for defining a configuration of IP security tunnels with the following limitations which are met by Bendinelli:

a) exchanging identification data with a remote computer system (Col 17, lines 21-65; Col 10, line 60 to Col 11, line 8);

b) determining, based on the identification data, whether a predefined security policy exists corresponding to the remote computer system (Col 17, lines 21-65; Col 10, line 60 to Col 11, line 8);

c) selecting a security policy specification format capable of being utilized by a plurality of different operating systems and a plurality of different machine types if a predefined security policy is absent (Col 17, lines 36-63);

d) said system for automatically configuring an IP security tunnel between the data processing system and the remote computer system utilizing said security policy specification format (Col 17, lines 36-63).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 15-17, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bendinelli in view of Pfeiffer (Pfeiffer, Ralf I. March 2, 1999. XML Tutorials for Programmers. retrieved from <http://www.informatik.hu-berlin.de/~xing/Lib/RIP-writing.pdf>).

Art Unit: 2137

As per claims 2-4, 15-17, and 28-30, the applicant describes the system of claims 1, 14, and 27, which are met by Bendinelli (see above), with the following limitations which are met by Bendinelli in view of Pfeiffer:

a) Establishing a security policy specification format capable of being utilized by a plurality of different operating systems and a plurality of different machine types (Bendinelli: Col 17, lines 36-63);

b) Establishing said security policy specification format being established as a DTD file (Bendinelli: Col 17, lines 36-63; Pfeiffer: pages 5-6);

Bendinelli discloses all the limitations of independent claims 1, 14, and 27. However, Bendinelli discloses that the security policy specification format is established as an XML file, not a DTD file. Pfeiffer discloses that a DTD file commonly stores policy and rules. Combining Pfeiffer with Bendinelli would allow the security policy specification format to be stored in a DTD file instead of an XML file. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to incorporate the ideas of Pfeiffer with those of Bendinelli because a DTD file is another means to store a security policy specification format and DTD files typically store policy and rules.

Response to Arguments

Applicant's arguments with respect to the 102(e) rejection of claim 1 under D'Sa have been fully considered but they are not persuasive. Applicant argues, substantially, that D'Sa does not teach the following:

a) a security policy specification format capable of being utilized by a plurality of different operating systems and a plurality of machine types

b) defining a configuration of an IP security tunnel utilizing said security policy specification format

Examiner notes that both (a) and (b) were addressed in the previous action (see final action, mailed 8/23/05, page 6, line 6 to page 7, line 15). It appears that applicant has reiterated substantially the same argument as presented in the previous Remarks (see Remarks filed 7/20/05) without addressing Examiner's comments.

Art Unit: 2137

Applicant's arguments with respect to the 102(e) rejection of claims 6, 11-13, 16, 24-26, 29, 37-39, and 39 under D'Sa have been fully considered but they are not persuasive. It appears that applicant has reiterated substantially the same argument as presented in the previous Remarks (see Remarks filed 7/20/05) without addressing Examiner's comments.

5

Applicant's arguments with respect to the 102(e) rejection of claims 1, 14, and 27 under Bendinelli have been fully considered but they are not persuasive. It appears that applicant has reiterated substantially the same argument as presented in the previous Remarks (see Remarks filed 7/20/05) without addressing Examiner's comments.

10

Applicant further alleges that Bendinelli does not teach "exchanging identification data with a remote computer system" and "determining whether a predefined security policy exists corresponding to the remote computer system" (see Remarks page 11). Examiner respectfully disagrees, and notes that the claim limitations are found at least in the newly cited passages for these limitations (See Col 17, lines 21-65 and Col 10 line 60 to Col 11, line 8). Accordingly, the rejection has been maintained.

15

Applicant's arguments with respect to the 103(a) rejection of claim 2 under Bendinelli in view of Pfieffer has been fully considered but they are not persuasive. The applicant argues motivation and hindsight. Such an argument is not persuasive on any level.

It is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In *re Jacoby*, 309 F.2d 738, 226 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In *re Bozek*, 416 F. 2d 738, 1385 USPQ 545 (CCPA 1969) and *In re Nilssen*, 851 F. 2d 1401-

Art Unit: 2137

1403, 7 USPQ 2d 1500-1502 (Fed. Cir. 1990). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F.2d 656, 193 USPQ 545 (CCPA 1977).

5 In the instant case, there is motivation to store the security policy specification format in a DTD file instead of an XML file because a DTD file is a common means of storing a format, such as a security policy specification format, and it is well-known that a DTD file typically stores policy and rules.

10 In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

15 This action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

25 Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


EMMANUEL L. MOISE
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